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In re Application of : COMMUNICATION
IIDA, Shigeru, et al. :
U.S. Application No.: 10/575,114 :
PCT No.: PCT/JP2004/015317 :
International Filing Date: 08 October 2004 :
Claimed Priority Date: 09 October 2003 :
Attorney's Docket No.: BJS-249-422 :
For: ANTIBODY COMPOSITION :
SPECIFICALLY BINDING TO :
GANGLIOSIDE GM2 :
:

This communication is issued in response to applicants' 09 June 2008 submission of a declaration in which the name of the third inventor differs from the name of record for such inventor.

BACKGROUND

On 08 October 2004, applicants filed international application PCT/JP2004/015317. The application claimed a priority date of 09 October 2003, and it designated the United States. On 21 April 2005, the International Bureau (IB) communicated a copy of the international application to the United States Patent and Trademark Office (USPTO). The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 10 April 2006 (09 April 2006 was a Sunday). The published international application identifies the third inventor as Miho URAKUBO.¹

On 10 April 2006, applicants filed a Transmittal Letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee.

On 07 March 2008, the United States Designated/Elected Office (DO/EO/US) mailed a Notification Of Missing Requirements (Form (PCT/DO/EO/905) requiring submission of an executed oath or declaration in compliance with 37 CFR 1.497, an English translation of the international application, and sequence listing materials.

On 09 June 2008, applicants filed a response to the Notification Of Missing Requirements (with required extension fee). The response included an English translation of the

¹ It is noted that the bibliographic information for this application listed at the WIPO website identifies this inventor by a different name, Miho INOUE.

international application, sequence listing materials, and the executed declaration considered herein. The declaration identified the third inventor as Miho TAKABE.²

DISCUSSION

Section 1893.01(e) of the Manual Of Patent Examining Procedure (“MPEP”) states the following:

Where ... the name of an inventor indicated in the international application during the international phase has changed such that the inventor's name is different from the corresponding name indicated in an oath or declaration submitted under 37 CFR 1.497, for example, on account of marriage, then a petition under 37 CFR 1.182 will be required to accept the oath or declaration with the changed name. See MPEP § 605.04(c). However, where the discrepancy between the name of the inventor indicated in the international application during the international phase and the name of the inventor as it appears in the oath or declaration submitted under 37 CFR 1.497 is the result of a typographical or transliteration error, then a petition under 37 CFR 1.182 will not be required. In such case, the Office should simply be notified of the error.

In the present application, the discrepancies between the third inventor's name listed in the published international application (URAKUBO), on the WIPO website (INOUE), and in the filed declaration (TAKABE) are more than “typographical or transliteration errors.”

Accordingly, in order to correct the name of record for this inventor to correspond with the name listed on the declaration, a grantable petition under 37 CFR 1.182 is required.

Section 605.04(c) of the MPEP, referred to above, sets forth the requirements for a petition under 37 CFR 1.182 to correct an inventor's name. According to the MPEP, such a petition “must include an appropriate petition fee and a statement signed by the inventor setting forth both names and the procedure whereby the change of name was effected, or a copy of the court order.” In the present case, where there is more than one prior name for this inventor contained in the application documents, the statement executed by the inventor should set forth and explain all three names (i.e., URAKUBO, INOUE, and TAKABE).

Applicants have not submitted the required petition under 37 CFR 1.182 to correct the name of record for the third inventor to correspond to the name listed on the filed declaration. Until such a petition is filed, the declaration filed 09 June 2008 is defective under 37 CFR 1.497 for failure to properly identify the inventors of record herein.

CONCLUSION

The declaration filed on 09 June 2008 is not acceptable under 37 CFR 1.497 for failure to properly identify the current inventors of record.

² Applicants' 09 June 2008 submission also included the \$130 surcharge and \$130 processing fee for submitting the declaration and translation later than thirty months after the priority date. Because this surcharge and processing fee had previously been paid herein, the duplicative surcharge and processing fee filed 09 June 2008 will be refunded to applicants' Deposit Account.

Applicants have **ONE (1) MONTH** from the mail date of this decision to file a proper response. Failure to file a proper response in a timely manner will result in **ABANDONMENT** of the application.

Extensions of time are **NOT** available under 37 CFR 1.136(a). However, the response period for the Notification Of Missing Requirements mailed 07 March 2008 may be extended up to a maximum of five months.

A proper response must include a grantable petition under 37 CFR 1.182 correcting the name of record for the third inventor to Miho TAKABE (as listed on the executed declaration) so as to permit acceptance of the declaration filed 09 June 2008.

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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